

REMARKS/ARGUMENTS

Applicants respond herein to the Office Action of October 3, 2008.

Claims 1-36 are pending in the Application with Claims 13-33 and 36 being withdrawn from consideration. Applicants amend Claims 1 and 34 and respectfully request reconsideration of the rejections. Claim 1 was amended for reasons of clarity only.

Information Disclosure Statement

In the Office Action, the Examiner indicated that the reference No. 61-268244 was submitted without an English abstract. Applicant respectfully advises the Examiner that the application was filed in the Japanese Patent Office without an Abstract and therefore, no English translation thereof is available.

Response to Claim Rejections

Claims 1-12, 34 and 35 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Kubota (4,989,588) in view of Walz (5,540,702).

Claim 1 recites an endoscopic lithotripsy apparatus having a probe, an ultrasonic vibration source 33 transmitting an ultrasonic vibration when the vibration source 33 is connected to a proximal end of the probe, and a mechanical shock generation source 50, which applies a force to the ultrasonic vibration source when the vibration source 33 is disconnected from the proximal end of the probe. The endoscopic lithotripsy apparatus further includes a switch mechanism to switch between the ultrasonic vibration source and the mechanical shock generation source. Similarly, Claim 34 recites a lithotripsy method which includes the step of “using a switch mechanism to switch between applying the mechanical shock with the mechanical shock generation source and connecting the ultrasonic vibration source to the proximal end of the probe.” These limitations of Claims 1 and 34 are not disclosed in the cited prior art.

Kubota discloses a medical treatment device utilizing ultrasonic vibration. See, Kubota, Abstract. Walz, on the other hand, discloses a stone crushing device generating a shock wave. See, Walz, Abstract. The Examiner believes that it would have been obvious to one of ordinary skill in the art to modify Kubota with a setup for a mechanical shock generator as taught by Walz. See, Office Action, page 3. Applicants respectfully disagree.

Under MPEP 2143, to reject a claim as obvious under 35 U.S.C. 103(a), an Examiner must first find that the prior art included each element claimed in the claim being rejected.

However, contrary to the recitation of Claims 1 and 34, neither Kubota nor Walz disclose a switch mechanism switching between the mechanical shock generating source and the ultrasonic vibration source. Therefore, in accordance with the MPEP, the Examiner's rationale cannot be used to support a conclusion that Claims 1 and 34 would have been obvious to one of ordinary skill in the art.

Therefore, Claims 1 and 34 are allowable over the prior art of record. Claims 2-12 and 35 depend from Claims 1 and 34, respectively. Therefore, Claims 2-12 and 35 are allowable over the cited prior art at least for the same reasons as Claims 1 and 34 and further on their own merits.

Moreover, dependent Claims 6-10 were rejected in the Office Action over the same prior art as Claim 1. However, the written rejection does not address the limitations recited in these claims. Such piecemeal examination is discouraged by 37 C.F.R. §1.105 and MPEP §707.07(g). It is requested that any future Office Action indicate allowability of any claim that recites a limitation against which no prior art is cited.

Favorable reconsideration of the rejections and allowance of all pending claims are respectfully requested.

THIS CORRESPONDENCE IS BEING
SUBMITTED ELECTRONICALLY
THROUGH THE UNITED STATES
PATENT AND TRADEMARK OFFICE
EFS FILING SYSTEM
ON DECEMBER 11, 2008

Respectfully submitted,



MAX MOSKOWITZ
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700